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Response to Office Action Dated August 28, 2003
November 26, 2003

REMARKS

I. Introduction and Overview

Favorable reconsideration and allowance of the present claims, as now amended, is respectfully requested.

Claims 1-29 are pending in the present application. Claims 1-29 are generally directed to an online or computerized method and system for enabling an individual (a sender) to order a gift-gram. The gift-gram includes a paper greeting message that can be customized or personalized and has included therewith or attached thereto a negotiable payment instrument, such as a check or money order (p. 11, lines 18-22; p. 12, line 5) (referred to as a "gift-gram"). The method and system are designed to facilitate purchase of the gift-gram through a computer and yet provide for direct physical delivery of the gift-gram to a recipient (p. 1, lines 22-24 through p. 2, lines 5-6; p. 7, lines 17-19; FIG. 7; FIG. 12). The payee specified on the gift-gram is not necessarily the recipient of the gift-gram.

Claims 1, 3, and 17 are presently amended, Claims 9 and 10 are canceled, and Claim 29 is new. Since two claims have been cancelled and only one new claim has been added and since Applicant only submitted two independent claims with the original filing, it is believed that no additional claim fees are required with this Amendment.

More specifically, Claims 1 and 17 have been amended to clarify that Applicant's invention includes interaction between the sender of a gift-gram and an online seller of the gift-gram, whereby the sender has access to an online server of the seller, and the sender directs the seller to create and send to a recipient a customized greeting message and an associated negotiable instrument made payable to a payee. The seller requests payment authorization for the monetary value of the payment instrument and, after payment authorization is obtained, the online seller generates both the negotiable instrument and the message for direct delivery to the recipient. Support for the amendment to Claim 1 can be found at least on p. 1, lines 22-24 through p. 2, lines 5-6, p. 13, lines 5-6 and 21-22, p. 15, lines 10-12, p. 24, lines 6-20, and p. 33, lines 5-14. Support for the amendment to Claim 17 can be found at least on p. 1, lines 22-24 through p. 2, lines 5-6, p. 7, lines 17-19, p. 13, lines 5-6 and 21-22, p. 15, lines 10-12, p. 24, lines

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6-20, and p. 33, lines 5-14. Claim 3 is amended to conform to the language used in Claim 1 and is not intended to be further limiting in any manner. Support for the amendment to Claim 3 can be found at least on p. 8, lines 9-10, and p. 13 lines 5-6. Thus, no new matter is presented.

Claim 29 is similar to Claims 1 and 17 but includes the specific limitations of receiving a requested mailing date for the negotiable instrument from the sender, printing the customized message on the stub portion of the negotiable instrument, and causing the mailing of the printed negotiable instrument on the mailing date requested by the sender.

II. Rejection under 35 U.S.C. §103(a) over various combinations of U.S. Patents 5,960,412 to Tackbary et al.; 6,453,300 to Simpson; 5,299,295 to Kim et al.; and 5,893,080 to McGurl et al.

In the Office Action dated August 28, 2003, Claims 1-28, and in particular Claims 1 and 17, were rejected under 35 U.S.C. §103(a) as being obvious over Tackbary or Simpson in view of McGurl or Kim. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or combination of references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

A. Review of the Cited References

U.S. Patent 5,960,412 to Tackbary et al. ("Tackbary") is directed to a method for on-going management, selection, and delivery of social expression cards (col. 1, lines 19-22). This system is quite similar to the known online greeting card systems described in the Background of the Invention of the present application. A user is able to access the

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owner's database via the Internet, store occasion dates, select a card, and have it delivered to a recipient (col. 2, lines 47-50; col. 4, lines 9-11).

U.S. Patent 6,453,300 to Simpson ("Simpson") is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). The greeting card of Simpson may typically be provided as a shape suitable for containing a CD or other similarly shaped storage medium (col. 3, lines 37-39). Through various techniques described in Simpson, a personalized message stored in the seller's database becomes associated with identification data on the CD (col. 5, lines 33-38). When the recipient receives the greeting card of Simpson, the recipient inserts the CD into a CD-ROM drive and plays the CD (col. 5, lines 44-46). The CD automatically directs the recipient to a website where data is stored by the seller of the greeting card (col. 5, lines 54-56). The greeting then displays for the recipient to view (col. 5, lines 58-61). After the personalized message is displayed, a generic set of information stored on the CD is then displayed (col. 6, lines 1-2, 14-15, 20-24). Specifically, a subset of a larger generic set is displayed (col. 6, lines 24-28). For example, the CD may contain interesting facts about dates in each month of the year, and only the month of birth of the recipient is then displayed (col. 6, lines 9-11).

U.S. Patent 5,893,080 to McGurl et al. ("McGurl") is directed to a computerized payment disbursement system (col. 2, lines 44-45). McGurl essentially teaches a computerized checking account where disbursement data is stored, recalled, archived, and/or inputted, and financial reports are generated (col. 4, lines 45-47; col. 4, lines 21, 54, 60). McGurl is primarily directed to methods and systems for having disbursements (electronic or printed checks) made in such a manner that unauthorized disbursements from the system are prevented.

U.S. Patent 5,299,295 to Kim et al. ("Kim") is directed to an electronic calculator for viewing, printing, and registering checks (col. 2, lines 66-67). In essence, Kim is directed to a hand-held electronic checkbook (col. 3, lines 37-38) used for electronically viewing, printing, and registering checks (col. 3, lines 38-39). The electronic checkbook

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of Kim includes a printer assembly having a check feed mechanism that operates in conjunction with a print head so that as the check is being fed past the print head, the check information is printed on the check (col. 7, lines 12-15).

B. Combination of References are Improper and Fail to Teach the Present Invention

Applicant submits that the combination of Tackbary or Simpson with McGurl or Kim is insufficient to support a rejection under 35 U.S.C. §103. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Such suggestion or motivation cannot be based on the Applicant's own disclosure. Applicant submits that there is no suggestion or motivation to combine any of the cited references. Furthermore, even if the references are combined, each combination of references fails to teach or suggest all elements of Applicant's claimed invention.

1. Combination of Tackbary and Kim

Tackbary is directed to a method for on-going management, selection, and delivery of social expression cards (col. 1, lines 19-22). Tackbary does not teach or suggest use of an electronic checkbook by a sender to generate checks or greeting cards. In fact, Tackbary teaches that it is often inconvenient for a user to have to buy stamps, keep track of addresses, and make trips to the post office to mail cards (col. 1, lines 35-40). Kim, on the other hand, is directed to an electronic checkbook and calculator. Kim fails to teach or suggest use of an electronic checkbook to generate a social expression card. It also fails to teach or suggest use of the Internet to perform transactions. In fact, an object of the invention of Kim is to provide "an electronic calculator which is portable, compact, durable, lightweight, easy to use, and energy efficient" (col. 2, lines 30-33). Kim has no relevance to the present invention. Thus, one of skill in the art would not look to the teachings of Kim to modify Tackbary. Given that there is no suggestion or motivation to combine the teachings of Tackbary and Kim, the rejection under §103(a)

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with respect to the combination of Tackbary and Kim is improper and should be withdrawn.

Even if Tackbary and Kim are combined, the combination fails to teach all elements of Applicant's claimed invention. Neither reference, alone or in combination, teaches creation and printing of a greeting message with a negotiable instrument (or a negotiable instrument with a greeting message) by a third party online seller for direct delivery by the seller to the recipient at the request of the sender. Tackbary, in passing, states that a "check" or "charitable contribution" could be included with the greeting card (FIG. 5 (indicia); col. 9, lines 49-50); however, there is no explanation or even thought to how this could actually be accomplished. Tackbary fails to enable the reader with an understanding of who would generate the check, how the payee would be specified, how the amount of the negotiable instrument would be specified, how the check would be forwarded to a payee, how the check would be included with the greeting, if at all, and so forth.

Specifically, with respect to Claim 1, Tackbary fails to teach enabling the sender to specify a payee for the negotiable payment instrument, enabling the sender to specify the monetary value of the negotiable payment instrument, requesting payment authorization for at least the monetary value of the negotiable payment instrument based on billing information provided by the sender, and after payment authorization has been obtained, printing the message and negotiable payment instrument by the seller. With respect to Claim 17, Tackbary fails to teach a computer network system including a means for specifying a payee for the negotiable payment instrument, means for selecting the monetary value of the negotiable payment instrument, means for specifying billing information for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender, means for requesting billing authorization from the financial institution of the sender, means for printing the message and negotiable payment instrument, and means for mailing the message and negotiable payment instrument to the recipient. Likewise, with respect to Claim 29, Tackbary fails to teach a method of directing the seller to create and send to a recipient a printed negotiable payment instrument having a customized greeting message, including

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receiving payee information from the sender, the payee information specifying the payee for the negotiable payment instrument, enabling the sender to specify a monetary value of the negotiable payment instrument, printing the negotiable payment instrument, the message included on a stub portion of the negotiable payment instrument, the negotiable payment instrument made payable to the payee and for an amount corresponding to the monetary value selected by the sender, and causing the printed negotiable instrument to be mailed to the mailing address of the recipient on the requested mailing date.

The disclosure of Kim is not sufficient to overcome the deficiencies of Tackbary. Kim does not teach or suggest use of a third party seller to send and create a negotiable instrument for delivery to a recipient. As such, Kim fails to teach or suggest how a third party seller would generate a negotiable instrument on behalf of an online buyer for direct delivery to a recipient, how the buyer would pay for the negotiable instrument, and so forth.

Thus, the combination of Tackbary and Kim fails to teach creation and printing of a greeting with a negotiable instrument by a third party online seller for direct delivery by the seller to a recipient. Given that the combination of Tackbary and Kim fails to teach and enable every element of Applicant's claimed invention, the rejection under §103(a) with respect to the combination of Tackbary and Kim is improper and should be withdrawn from Claims 1 and 17 and is not applicable to new Claim 29.

2. Combination of Tackbary and McGurl

Applicant submits that it is improper to combine the teachings of Tackbary with the teachings of McGurl. As stated above, Tackbary is directed to a method for on-going management, selection, and delivery of social expression cards (col. 1, lines 19-22). Tackbary fails to teach or suggest how one would combine its system for creating a social expressions card with a computerized disbursement system. As stated above, McGurl is directed to a computerized payment disbursement system (col. 2, lines 44-45) for generating standard electronic or printed payments in a secure manner. McGurl fails to teach or suggest use of a computerized disbursement system in combination with a system for creating social expression cards. Given that there is no motivation or

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suggestion to combine the references, the combination of Tackbary and McGurl is improper and should be withdrawn.

Even if the references are combined, the combination fails to disclose all elements of Applicant's claimed invention. Neither reference, alone or in combination, teaches direct creation and delivery of a printed greeting card with a negotiable instrument by a third party online seller. As stated above, Tackbary alludes to inclusion of a check or charitable contribution with the social expression card, but Tackbary fails to enable the reader with an understanding of who would generate the check, how the payee would be specified, how the amount of the negotiable instrument would be specified, how the check would be forwarded to a payee, and so forth.

Specifically, with respect to Claim 1, Tackbary fails to teach enabling the sender to specify a payee for the negotiable payment instrument, enabling the sender to specify the monetary value of the negotiable payment instrument, requesting payment authorization for at least the monetary value of the negotiable payment instrument based on billing information provided by the sender, and after payment authorization has been obtained, printing the message and negotiable payment instrument by the seller. With respect to Claim 17, Tackbary fails to teach a computer network system including a means for specifying a payee for the negotiable payment instrument, means for selecting the monetary value of the negotiable payment instrument, means for specifying billing information for the message and the negotiable instrument, wherein the billing information includes a financial institution of the sender, means for requesting billing authorization from the financial institution of the sender, means for printing the message and negotiable payment instrument, and means for mailing the message and negotiable payment instrument to the recipient. Likewise, with respect to Claim 29, Tackbary fails to teach a method of directing the seller to create and send to a recipient a printed negotiable payment instrument having a customized greeting message, including receiving payee information from the sender, the payee information specifying the payee for the negotiable payment instrument, enabling the sender to specify a monetary value of the negotiable payment instrument, printing the negotiable payment instrument, the message included on a stub portion of the negotiable payment instrument, the negotiable

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payment instrument made payable to the payee and for an amount corresponding to the monetary value selected by the sender, and causing the printed negotiable instrument to be mailed to the mailing address of the recipient on the requested mailing date.

The disclosure of McGurl is not sufficient to overcome the deficiencies of Tackbary. McGurl does not teach or suggest use of a third party seller to create and deliver to a recipient a customized greeting with a negotiable instrument. Instead, McGurl teaches creation and printing of checks by a user of an electronic disbursement system. Furthermore, contrary to the present invention, McGurl does not teach or suggest requiring authorization prior to the user's issuance of a check. Rather, "once the user indicates to the system... that the disbursement is acceptable, the system then effectuates the disbursement" (col. 5, lines 12-15). Thus, the combination of Tackbary and McGurl fails to teach directing a third party online seller to create and print a greeting with a negotiable instrument for direct delivery to a recipient. Given that the combination of Tackbary and McGurl fails to teach and enable every element of Applicant's claimed invention, the rejection under §103(a) with respect to the combination of Tackbary and McGurl is improper and should be withdrawn from Claims 1 and 17 and is not applicable to new Claim 29.

3. Combination of Simpson and Kim

Applicant submits that it is improper to combine the teachings of Simpson with the teachings of Kim. Simpson is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). Simpson does not teach or suggest use of an electronic calculator or checkbook to generate the CD gift. Likewise, Kim is directed to an electronic checkbook having a printing mechanism (col. 2, lines 66-67). Kim does not teach or suggest use of an electronic checkbook to design a greeting card of any kind, and in particular, Kim does not teach or suggest use of an electronic checkbook to make a CD gift or CD gift card. Given that there is no suggestion or motivation to

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combine the teachings of Simpson and Kim, Applicant submits that the combination of Simpson and Kim is improper and the rejection under §103(a) should be withdrawn.

Even if the references are combined, the combination fails to teach or suggest all elements of Applicant's claimed invention. Specifically, neither reference, alone or in combination, teaches or suggests having a third party online seller generate a negotiable instrument for direct delivery to a recipient/payee. As stated above, Simpson is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). Simpson fails to teach or suggest having a third party online seller generate a negotiable instrument for direct delivery to a recipient/payee.

The teachings of Kim are insufficient to overcome the deficiencies of Simpson. Kim is directed to an electronic checkbook having a printing mechanism (col. 2, lines 66-67). Kim does not teach or suggest using a third party online seller to generate a negotiable instrument for direct delivery to a recipient. Thus, the combination of Simpson and Kim fails to teach directing a seller to create a printed greeting message having a negotiable payment instrument included therewith for direct delivery to a recipient. Given that the combination of Simpson and Kim fails to teach and enable every element of Applicant's claimed invention, the rejection under §103(a) with respect to the combination of Simpson and Kim is improper and should be withdrawn from Claims 1 and 17 and is not applicable to new Claim 29.

4. Combination of Simpson and McGurl

Applicant submits that it is improper to combine the teachings of Simpson and McGurl. Simpson is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). Simpson does not teach or suggest use of a computerized disbursement system such as that described in McGurl to generate the CD gift card. McGurl is directed to a computerized payment disbursement system (col. 2,

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lines 44-45). McGurl does not teach or suggest use of the payment disbursement system to generate gift cards or CD gift cards. Given that there is no suggestion or motivation to combine the teachings of Simpson and McGurl, Applicant submits that the combination of Simpson and McGurl is improper and the rejection under §103(a) should be withdrawn.

Even if the references are combined, the combination fails to teach or suggest every element of Applicant's invention. Specifically, neither reference, alone or in combination, teaches directing a third party online seller to generate a negotiable instrument and deliver it directly to a recipient/payee. As stated above, Simpson is directed to an improved greeting card having an electronic storage media, such as a compact disk (CD), contained therein, and a method of enabling the purchaser of the card to personalize the card for the intended recipient for whom the card was purchased (col. 1, lines 18-24). Simpson fails to teach or suggest having a third party online seller generate a negotiable instrument for direct delivery to a recipient/payee.

The teachings of McGurl are insufficient to overcome the deficiencies of Simpson. McGurl is directed to a computerized payment disbursement system (col. 2, lines 44-45). McGurl does not teach or suggest using a third party online seller to generate a negotiable instrument for direct delivery to a recipient. Furthermore, contrary to the present invention, McGurl does not teach or suggest requiring authorization prior to the user's issuance of a check. Rather, "once the user indicates to the system... that the disbursement is acceptable, the system then effectuates the disbursement" (col. 5, lines 12-15). Thus, the combination of Simpson and McGurl fails to teach directing a seller to create a printed greeting message having a negotiable payment instrument included therewith for direct delivery to a recipient. Given that the combination of Simpson and McGurl fails to teach or suggest every element of Applicant's claimed invention, the rejection under §103(a) is improper and should be withdrawn from Claims 1 and 17 and is not applicable to new Claim 29.

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C. Conclusion

Applicant respectfully submits that the various combinations of Tackbary, Simpson, Kim, and McGurl to support a rejection under 35 U.S.C. §103 are improper and should be withdrawn from Claims 1 and 17 and are not applicable to new Claim 29 for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of this rejection.

For at least the reasons stated above, it is respectfully submitted that all of the present claims, as now amended, are in condition for allowance.

Respectfully submitted on behalf of Applicant,

By: 

Jack D. Todd

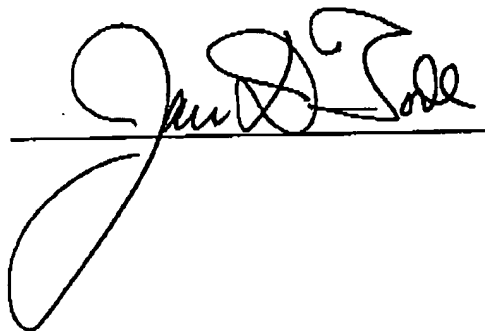
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CERTIFICATE OF FACSIMILE

I, Jack D. Todd, hereby certify that on November 26, 2003 this document for Application Serial No. 09/737,912 is being sent by facsimile to the attention of Examiner Nguyen in Group Art Unit 3625 at facsimile number (703) 305-7687.

A handwritten signature in cursive script, appearing to read "Jack D. Todd", is written over a horizontal line. The signature is fluid and stylized, with a large loop at the end.

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